

**RECEIVED
CENTRAL FAX CENTER**

JUN 27 2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant: James F. Desmond
Serial No.: 10/718,361
Technology Center: 3700
Art Unit: 3721
Filed: November 19, 2003
Title: "PORTABLE STORAGE KIT SYSTEM"
Examiner: Sameh H. Tawfik
Docket No.: P02784

APPEAL BRIEF

	<u>Page</u>
I. INTRODUCTION	A2
II. REAL PARTY IN INTEREST.....	A2
III. RELATED APPEALS AND INTERFERENCES	A2
IV. STATUS OF CLAIMS	A2
V. STATUS OF AMENDMENTS	A2
VI. SUMMARY OF CLAIMED SUBJECT MATTER	A3-A9
VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	A10-A11
VIII. ARGUMENT	A11-A23
IX. CONCLUSION	A24
X. CLAIMS APPENDIX	A25-A28
XI. EVIDENCE APPENDIX	A29
XII. RELATED PROCEEDINGS APPENDIX	A30

I. INTRODUCTION

This Appeal is from a Non-Final Office Action mailed on March 5, 2007, rejecting Claims 16-28, 30-32, 47, 53-55, 57 and 61 of the current application. Applicant has reinstated the Appeal after prosecution was reopened setting forth new grounds for rejection. Applicant commenced this Appeal by Notice of Appeal and submission of this Appeal Brief, both filed on June 27, 2007.

II. REAL PARTY IN INTEREST

James F. Desmond.

III. RELATED APPEALS AND INTERFERENCES

None.

IV. STATUS OF CLAIMS

Claims 16-28, 30-32, 47, 53-55, 57, and 61 are pending, and are under appeal. Claims 1-15, 29, 33-46, 48-52, 56, and 58-60 are canceled. The claims on appeal are set forth in the attached Appendix. Claim 47 is an independent claim. Claims 16-28, 30-32, 53-55, 57 and 61 depend directly or indirectly from Claim 47.

V. STATUS OF AMENDMENTS

Under 37 CFR 1.116, in order to present the rejected claims in better form for consideration on appeal, an amendment was submitted after final rejection¹.

VI. SUMMARY OF CLAIMED SUBJECT MATTER

¹ In the May 2, 2006, Final Rejection, the Examiner objected to Claims 26 and 29 because they depended from canceled Claim 51. An After Final Amendment was submitted to amend Claim 26, as well as Claim 18, so they now properly depend on Claim 47. Applicant has canceled Claim 29 and subsequently amended Claim 30 for proper dependency.

Summary of Independent Claim 47:

“An adapter element system kit, for assisting pouring of a flowable substance from at least one first container comprising at least one first threaded opening to at least one second container having at least one second threaded opening” shown in FIG. 1 and most clearly described in the paragraphs starting on page 14, line 20 of applicant’s specification.

“at least one adapter cap comprising at least one Yorker tip” shown in FIG. 1 and most clearly described in the paragraphs starting on page 14, line 28 of applicant’s specification as adapter cap **114**.

“wherein said at least one adapter cap is structured and arranged to connect to the at least one first threaded opening of the at least one first container” shown in FIG. 2 and most clearly described in the paragraphs starting on page 17, line 25 of applicant’s specification as adapter cap **114**.

“at least one receiving adapter comprising at least one access structured and arranged to flowably connect with said at least one Yorker tip of said at least one adapter cap” shown in FIG. 24 and most clearly described in the paragraphs starting on page 24, line 21 of applicant’s specification as receiver adapter cap **406**.

“wherein said at least one receiving adapter comprises at least one threaded port structured and arranged to connect with said at least one second opening of said at least one second container” shown in FIG. 25 and most clearly described in the paragraphs starting on page 25, line 3 of applicant’s specification as adapter cap **406**.

“the at least one second container” shown in FIG. 1 and most clearly described in the paragraphs starting on page 12, line 27 of applicant’s specification, as well as in FIG. 24 and most clearly described in the paragraphs starting on page 24, line 12 of applicant’s specification as flexible squeeze tube **402**.

“wherein said at least one receiving adapter is structured and arranged so that the flowable substance may be transferred through said at least one adapter cap connected to said at least one receiving adapter directly from the at least one first container to said at least one second container” shown in FIG. 26 and most clearly described in the paragraphs starting on page 14, line 20 of applicant’s specification.

“wherein said second container comprises at least one flexible squeeze tube” shown in FIG. 1 and most clearly described in the paragraphs starting on page 12, line 27 of applicant’s specification, as well as in FIG. 24 and most clearly described in the paragraphs starting on page 24, line 12 of applicant’s specification as flexible squeeze tube **402**.

Summary of dependent Claim 16:

Claim 16 is dependent from Claim 47 with the further limitation of:

“a plurality of said receiving adapters” shown in FIG. 27 and most clearly described in the paragraphs starting on page 25, line 30 of applicant’s specification as receiving adapter caps **428**, **430**, and **432**.

Summary of dependent Claim 31:

Claim 31 is dependent from Claim 16 with the further limitation of:

“at least one set of instructions” shown in FIG. 27 and most clearly described in the paragraphs starting on page 16, line 23 of applicant’s specification as instructions **144**.

Summary of dependent Claim 17:

Claim 17 is dependent from Claim 16 with the further limitation of:

“a plurality of said second containers” shown in FIG. 27 and most clearly described in the paragraphs starting on page 25, line 33 of applicant’s specification as flexible squeeze tubes **422**, **424**, and **426**.

Summary of dependent Claim 23:

Claim 23 is dependent from Claim 17 with the further limitation of:

“a travel-bag structured and arranged to hold and portably transport said plurality of second containers, and said plurality of receiving adapters” shown in FIG. 27 and most clearly described in the paragraphs starting on page 16, line 25 of applicant’s specification as travel bag **146**.

Summary of dependent Claim 24:

Claim 24 is dependent from Claim 17 with the further limitation of:

“at least one second container comprising a first capacity, and at least one second container comprising a second capacity” shown in FIG. 27 and most clearly described in the paragraphs starting on page 12, line 26 of applicant’s specification as flexible bags **104** and **106**.

Summary of dependent Claim 32:

Claim 32 is dependent from Claim 17 with the further limitation of:

A “plurality of second containers” comprising “a plurality of flexible squeeze-tubes” shown in FIG. 27 and most clearly described in the paragraphs starting on page 25, line 33 of applicant’s specification as flexible squeeze tubes **422**, **424**, and **426**.

Summary of dependent Claim 18:

Claim 18 is dependent from Claim 47 with the further limitation of:

A “plurality of second containers” shown in FIG. 27 and most clearly described in the paragraphs starting on page 25, line 33 of applicant’s specification as flexible squeeze tubes **422**, **424**, and **426**.

Summary of dependent Claim 19:

Claim 19 is dependent from Claim 47 with the further limitation of:

“at least one plunger syringe” shown in FIG. 27 and most clearly described in the paragraphs starting on page 16, line 3 of applicant’s specification as syringe **140**.

Summary of dependent Claim 20:

Claim 20 is dependent from Claim 19 with the further limitation of:

“at least one plunger syringe” comprising “at least one catheter syringe with a capacity of about sixty cubic centimeters” shown in FIG. 27 and most clearly described in the paragraphs starting on page 16, line 3 of applicant’s specification as syringe **140**.

Summary of dependent Claim 21:

Claim 21 is dependent from Claim 19 with the further limitation of:

“at least one plunger syringe” further comprising “at least one flexible tube” shown in FIG. 27 and most clearly described in the paragraphs starting on page 16, line 5 of applicant’s specification as tubing **142**.

Summary of dependent Claim 22:

Claim 22 is dependent from Claim 21 with the further limitation of:

“at least one flexible tube... between about one-eighth inch diameter and about one-half inch diameter plastic tubing” shown in FIG. 27 and most clearly described in the paragraphs starting on page 16, line 3 of applicant’s specification as tubing **142**.

Summary of dependent Claim 25:

Claim 25 is dependent from Claim 47 with the further limitation of:

An “o-ring structured and arranged to assist in providing a seal between said at least one receiving adapter and said at least one second container” shown in FIG. 18 and most clearly described in the paragraphs starting on page 21, line 16 of applicant’s specification as o-ring **282**.

Summary of dependent Claim 26:

Claim 26 is dependent from Claim 47 with the further limitation of:

“at least one second container” comprising “at least one spout” shown in FIG. 27 and most clearly described in the paragraphs starting on page 13, line 32 of applicant’s specification as spout
112.

Summary of dependent Claim 27:

Claim 27 is dependent from Claim 26 with the further limitation of:

“at least one spout” comprising “at least one non-spill valve” shown in FIG. 27 and most clearly described in the paragraphs starting on page 14, line 1 of applicant’s specification as spout
112.

Summary of dependent Claim 28:

Claim 28 is dependent from Claim 26 with the further limitation of:

“at least one lanyard” shown in FIG. 14 and most clearly described in the paragraphs starting on page 21, line 3 of applicant’s specification as lanyard **280.**

Summary of dependent Claim 30:

Claim 30 is dependent from Claim 47 with the further limitation of:

“at least one flexible bag” comprising “at least one combination selected from the group consisting of: (a) bottom-gusset and at least one side gusset, (b) bottom-gusset only, and (c) at least one side gusset with bottom-fold” shown in FIGS. 20-23 and most clearly described in the paragraphs starting on page 23, lines 3, 17, and 30 of applicant’s specification as flexible bag **340.**

Summary of dependent Claim 53:

Claim 53 is dependent from Claim 47 with the further limitation of:

“at least one second container... smaller than the at least one first container” shown in FIG. 4 and most clearly described in the paragraphs starting on page 43, line 5 of applicant’s Abstract.

Summary of dependent Claim 54:

Claim 54 is dependent from Claim 47 with the further limitation of:

“at least one flexible squeeze-tube... structured and arranged so that it can be folded to expel substantially all air from within such flexible squeeze-tube” shown in FIG. 26 and most clearly described in the paragraphs starting on page 25, line 18 of applicant’s specification as flexible squeeze tube **402**.

Summary of dependent Claim 55:

Claim 55 is dependent from Claim 47 with the further limitation of:

“at least one o-ring structured and arranged to assist in providing a seal between said at least one receiving adapter cap and said at least one second threaded opening of the at least one second container” shown in FIG. 18 and most clearly described in the paragraphs starting on page 21, line 16 of applicant’s specification as o-ring **282**.

Summary of dependent Claim 57:

Claim 57 is dependent from Claim 47 with the further limitation of:

“at least one flexible squeeze-tube comprising: (a) at least one first end and at least one second end; (b) wherein said at least one empty flexible squeeze-tube is new and unused for containment; (c) wherein said at least one first end comprises a reclosable access system wherein said reclosable access system, when closed, seals such at least one first end; and (d) wherein said at least one second end comprises a permanent ‘linear’ tube seal closure” shown in FIGS. 31 and 32 and most clearly described in the paragraphs starting on page 27, line 25 of applicant’s specification as flexible tube **530**.

Summary of dependent Claim 61:

Claim 61 is dependent from Claim 47 with the further limitation of:

“at least one flexible squeeze-tube... structured and arranged so that it can be folded substantially flat” shown in FIG. 26 and most clearly described in the paragraphs starting on page 25, line 18 of applicant’s specification as flexible squeeze tube **402**, and alternatively, as shown in FIG. 23.

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following claim rejections were asserted in the Final Rejection:

- (A) Claims 25-28, 47, 53, 55 and 57 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,918,650 to Borden.
- (B) Claims 16-24, 30-32, 54 and 61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,918,650 to Borden.
- (C) Claims 16-28, 30-32, 47, 53-55, 57 and 61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,918,650 to Borden, in view of U.S. Patent No. 5,285,824 to Krstovic.

The issues before the Board are as follows:

35 U.S.C. §102(b)

ISSUE 1: Under 35 USC §102(b), does Borden's "liquid transfer system for bottles" (US 5,918,650) anticipate applicant's independent Claim 47?

ISSUE 2: Under 35 USC §102(b), does Borden's "liquid transfer system for bottles" anticipate applicant's dependent Claims 25 and 55?

ISSUE 3: Under 35 USC §102(b), does Borden's "liquid transfer system for bottles" anticipate applicant's dependent Claims 27 and 28?

ISSUE 4: Under 35 USC §102(b), does Borden's "liquid transfer system for bottles" anticipate applicant's dependent Claim 57?

35 U.S.C. §103(a)

ISSUE 5: Under 35 USC §103(a), are dependent Claims 16-24, 30-32, 54, and 61 unpatentable over Borden's "liquid transfer system for bottles"?

ISSUE 6: Under 35 USC §103(a), is independent Claim 47 unpatentable over Borden's "liquid transfer system for bottles", in view of Krstovic's "vehicle oil drainage apparatus and method"?

VIII. ARGUMENT

Applicant's Claims are Novel Under 35 U.S.C. §102(b)

ISSUE 1: Under 35 USC §102(b), does Borden's "liquid transfer system for bottles" (US 5,918,650) anticipate applicant's independent Claim 47?

The Examiner has rejected independent Claim 47 under 35 USC §102(b), as allegedly being anticipated by the Borden reference. Applicant respectfully submits that a case of anticipation under 35 USC §102(b) has not been established since the Borden reference does not disclose each and every element of Claim 47.

Applicant's independent Claim 47 sets forth the requirement that "(g)...said at least one second container comprises at least one flexible squeeze-tube". Applicant respectfully submits that the Borden reference does not disclose the at least one flexible squeeze-tube.

It is critical to Applicant's system that the second container is a flexible squeeze tube, which provides ease of transport and efficient storage, distinguishing Applicant's system from Borden's system. Because the Transportation Security Administration (TSA) limits air travelers from carrying liquids or gels in containers capable of holding three ounces or more, such products must either be discarded or placed in smaller containers. Applicant's invention allows such air travelers to conveniently transfer liquids or gels to flexible squeeze-tubes that hold less than three ounces. Nothing in the prior art discloses the transfer of such liquids or gels to such flexible squeeze-tubes.

This "flexible squeeze tube" limitation cannot be found anywhere in the Borden reference. The Borden reference clearly limits its descriptions to elements that are non-flexible within the meanings of Applicant's specification and claims. The Borden reference specifically describes

“bottles”, and each of the figures in the Borden reference shows rigid bottles (See Borden’s Detailed Description references to “bottle 38”; and all of the Claims and Figures). The new and useful ease of transport and efficient storage functions of Applicant’s flexible squeeze tube are not taught, described, suggested or enabled by the Borden reference.

Borden’s system requires gravity draining an upside down first bottle into a second receiving bottle, as shown in Borden’s Figure 1 (See also Borden’s Detailed Description column 3, lines 17-34). More specifically, Borden states, “The liquid transfer system for bottles is stable because the weight of the nearly full bottle is on the bottom with the nearly empty inverted bottle on top” (See Borden’s Detailed Description column 3, lines 31-34). Borden’s arrangement clearly requires the use of rigid, non-flat-when-empty bottles, which lack the spatially efficient storage function and ease-of-transport function provided by applicant’s system of using flat flexible squeeze-tubes. Moreover, Borden’s system could not be used to transfer many consumer products, such as toothpaste or hair gel, to a flexible squeeze-tube.

In rejecting Claim 47 the Examiner refers to “bottle” (38) in the Borden reference as the “at least one second container” comprising “at least one flexible squeeze-tube”. However, the Examiner admits later in the same Office action that the Borden reference does not disclose the “flexible squeeze-tube.” In rejecting Claim 47 on an alternate ground, the Examiner states, “Borden does not disclose the at least one second container (38) comprises at least one flexible squeeze tube (Office action, Page 8, Lines 13-14)”. Thus, the Examiner takes contradictory positions regarding the issue of whether the Borden reference discloses the “flexible squeeze-tube” feature.

Putting aside the clear error made in the Office action, the question arises as to whether this bottle 38 referred to by the Examiner is the “flexible squeeze-tube” described and claimed by Applicant. The Examiner asserts that “bottle 38 is capable of being [the] flexible squeeze tube as it is

made of plastic,” referring to Borden, at col., lines 14 and 15”, but the cited portion of the reference merely states: “Consumers today pay considerable sums of money for shampoos, liquid cleaning detergents, perfumes and other liquid products generally contained within glass or plastic bottles.”

As best understood, it appears that the Examiner’s position is that Borden’s bottle 38 could be made from plastic, and that because some plastic is relatively “flexible”, the bottle 38 is made from this “flexible” plastic. But does Borden really disclose that bottle 38 is made from a flexible plastic? A careful reading of Borden indicates that the material for bottle 38 is not expressly disclosed. Therefore, the Examiner’s contention that the bottle 38 is made of a flexible plastic is really one based on the doctrine of inherency. However, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Also, *see, In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); and MPEP §2112.

Furthermore, it is respectfully submitted that the Examiner has failed to reasonably construe the term “flexible squeeze-tube”. “Squeeze-tube” is an industry term referring to a small cylinder of metal or plastic sealed at one end and having a capped opening at the other from which paint, toothpaste, or some other semi-fluid substance may be squeezed. The main trade organization for the squeeze-tube industry, the Tube Council, maintains an informative Web Site (i.e., www.Tube.org) regarding squeeze-tubes, and every squeeze-tube depicted or described therein meets the above definition. The Tube Council describes itself as “a not-for-profit trade organization of businesses engaged in producing products or services related to the collapsible squeeze tube industry.” Furthermore, Applicant’s specification clearly defines the concept of a squeeze-tube by way of repeated usage. For example, Applicant’s Figure 24 shows a perspective view of a flexible squeeze tube assembly (400) clearly showing a squeeze-tube of the type mentioned above.

The MPEP requires that the words of the claim must be given their plain meaning. The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention. See, MPEP §2111.01(III). It is respectfully submitted that the term “squeeze-tube” was an industry term at the time the time of the invention customarily used by artisans of ordinary skill in the art to refer to a small cylinder of metal or plastic sealed at one end and having a capped opening at the other from which paint, toothpaste, or some other semi-fluid substance may be squeezed. Furthermore, it is respectfully submitted that the “bottle” disclosed by Borden would not have been considered a squeeze tube.

The courts have explained: “The **identical** invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); and “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently **described**, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053(Fed. Cir. 1987). Thus, Applicant respectfully submits that a case of anticipation under 35 USC §102(b) has not been established since the Borden reference does not disclose each and every element of Claim 47.

ISSUE 2: Under 35 USC §102(b), does Borden’s “liquid transfer system for bottles” anticipate applicant’s dependent Claims 25 and 55?

Applicant’s Claims 25 and 55 subsequently depend on independent Claim 47. Applicant repeats as though fully set forth here the above arguments regarding the Borden reference.

The Examiner has rejected Claims 25 and 55, stating “further comprising at least one o-ring structured and arranged to assist in providing a seal between the at least one receiving adapter cap and the at least one second threaded opening of the at least one second container (Fig. 1; via ribs 30 and 50)”. Applicant interprets this to mean the Examiner is taking the position that applicant’s o-ring **282**

is anticipated by Borden's rib **30** and groove **50**. Applicant's Claims 25 and 55 sets forth "at least one o-ring structured and arranged to assist in providing a seal between said at least one receiving adapter and said at least one second container". Applicant's o-ring **282** clearly functions as a sealer. The Borden reference teaches a rib **30** and groove **50** which function as a locking mechanism: "the first mating piece **12** is inserted into female end **40** in an axial direction such that the rib **30** snaps and locks into the groove **50** in a friction engagement" (See Borden's Description, Column 3, lines 1-3). The sealing function of applicant's o-ring **282** is not taught, described, suggested or enabled by the Borden reference.

Thus, applicant respectfully submits that a prima facie case of anticipation under 35 USC §102(b) has not been established since the Borden reference does not describe each and every element of Applicant's claims 25 and 55.

ISSUE 3: Under 35 USC §102(b), does Borden's "liquid transfer system for bottles" anticipate applicant's dependent Claims 27 and 28?

Applicant's Claims 27 and 28 subsequently depend on Claim 47. Applicant repeats as though fully set forth here the above arguments regarding the Borden reference.

The Examiner has rejected Claims 27 and 28, stating "Regarding claims 27 and 28: wherein the at least one spout comprises at least one non-spill valve and lanyard, see for example (Fig. 1)". This statement appears non-responsive to applicant. The Examiner appears to be taking the position that applicant's non-spill spouts **112** and lanyards **280** are taught by simply looking at FIG. 1 of the Borden reference.

The Borden reference does not teach non-spill spouts. Applicant's Claim 27 sets forth "at least one spout" comprising "at least one non-spill valve". Applicant's spout **112** clearly functions as a spout which minimizes spills and is specifically set forth as preferably being embodied as a

“Smartspout®” (See applicant’s Detailed Description page 14, line 13). The Borden reference simply teaches a “male end **24**”, making no mention of any ability to stop spills. The specific no-spill function of applicant’s invention, provided by using, for example, a spill minimizing spout **112**, is not taught, described, suggested or enabled by the Borden reference.

Similarly, the Borden reference does not teach lanyards. Applicant’s Claim 28 sets forth a “lanyard”, which can carry a flask **262** and a flexible bag **200**, among other things. The Borden reference makes no mention of lanyards or any other means for carrying a flask or flexible bag (See the Borden reference’s Detailed Description, as well as FIG. 1 as suggested by the Examiner). Applicant’s lanyard **280** is not taught, described, suggested or enabled by the Borden reference.

Thus, applicant respectfully submits that a prima facie case of anticipation under 35 USC §102(b) has not been established since the Borden reference does not describe each and every element of applicant’s Claims 27 and 28.

ISSUE 4: Under 35 USC §102(b), does Borden’s “liquid transfer system for bottles” anticipate applicant’s dependent Claim 57?

Applicant’s Claim 57 subsequently depends on independent Claim 47. Applicant repeats as though fully set forth here the above arguments regarding the Borden reference.

The Examiner has rejected Claim 57, stating that “via bottle **38** is inherently squeezable”. Applicant interprets that the Examiner is taking the position that the second container bottle **38** is squeezable and therefore anticipates Applicant’s Claim 57. Applicant respectfully disagrees in that the Borden reference makes no suggestion of ever ‘squeezing’ a bottle **38**, never mentions the word “squeeze” or anything functionally similar to it, nor does the Borden reference teach or suggest that a bottle **38** comprise a reclosable end as provided for by applicant’s system. In addition, and most

unique, the Borden reference does not teach or suggest that a bottle **38** comprise the ability to be filled from a second opening for convenient filling and refilling.

Applicant's Claim 57 sets forth a flexible tube **530** comprising "at least one first end and at least one second end; wherein said at least one empty flexible squeeze-tube is new and unused for containment; wherein said at least one first end comprises a reclosable access system wherein said reclosable access system, when closed, seals such at least one first end; and wherein said at least one second end comprises a permanent 'linear' tube seal closure", as best shown in applicant's FIGS. 31 and 32.

The Borden reference teaches that "the liquid transfer system for bottles is stable because the weight of the nearly full bottle is on the bottom with the nearly empty inverted bottle on top" (See Borden's Detailed Description column 3, lines 31-34). Borden's arrangement clearly requires the use of rigid, non-flat-when-empty bottles, which lack the flattening, reclosing, transport, and ease of storage functions provided by applicant's flat flexible tubes.

The flattening, reclosing, transport, ease of storage, and fill-from-a-second-opening functions of applicant's flexible tube **530** are not taught, described, suggested or enabled by the Borden reference. Thus, applicant respectfully submits that a prima facie case of anticipation under 35 USC §102(b) has not been established since the Borden reference does not describe each and every element of applicant's claim 57.

Applicant's Claims are Non-Obvious Under 35 U.S.C. §103(a)

ISSUE 5: Under 35 USC §103(a), are Claims 16-24, 30-32, 54, and 61 unpatentable over Borden's "liquid transfer system for bottles"?

Applicant respectfully submits that the novel inventions of Claims 16-24, 30-32, 54, and 61 are not obvious, and that the Examiner has not established a prima facie case of obviousness.

In rejecting the above claims, the Examiner has repeatedly taken the position that Applicant's system is obvious "...since it has been held that mere duplication of the essential working parts of a device/part involves only routine skill in the art." However, at no point has the Examiner established any motivation for such "duplication". For example, Claim 16 sets forth the requirement that there be "a plurality of said receiving adapters". Whereas merely mass producing or making spare parts might be obvious, it defies common sense to conclude that providing a plurality of second containers is necessarily obvious without articulating any motivation for doing so. It is respectfully submitted that the Examiner's reasoning is not persuasive.

In rejecting Claim 23, the Examiner takes Official Notice that "such travel bags to container [sic] human's needs [are] known, old, and available in the art." The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Borden's system, by having a travel bag to hold the containers and adapters, "as a matter of engineering design choice, in order to make it convenient carrying the product around." While Applicant does not challenge the Official Notice that travel bags are old in the art, it is respectfully submitted that the Examiner's rejection appears to be premised on impermissible hindsight reasoning.

In rejecting Claims 19-22, the Examiner admits that Borden does not disclose a plunger syringe comprising a catheter syringe with a capacity of about sixty cubic centimeters nor a flexible tube between about one-eighth inch diameter and about one half inch diameter plastic tubing. The Examiner then asserts that "as Applicant did not specifically claim/refer to the use of such syringe along with the adapter element system, it would have been obvious to one of ordinary skill in the art

at the time the invention was made to have modified Borden's system by adding syringe to the kit, if needed, in order to measure and control the amount of the transfer liquid."

It is respectfully submitted that the Examiner has failed to provide sufficient motivation for including a syringe or flexible tube within the specific dimensions and/or material set forth in Claims 19-22. Even assuming, *arguendo*, that there would have been motivation to include a measuring device in the kit, it is a huge leap to conclude that it would have been obvious to include a catheter syringe with a capacity of about sixty cubic centimeters. Furthermore, a review of Borden shows that a modification to Borden with a catheter syringe would provide no advantage or beneficial result. That is because Borden's system transfers liquid from a first container to a second container by gravity, and does not require that any fluid be "pushed" from the first bottle to the second bottle. Moreover, it is simply not clear what a user of Borden's system would do with such syringe. Furthermore, the general desire to measure and control the amount of liquid transferred would not have led an artisan of ordinary skill to make a flexible tube with the specific dimensions of between about one-eighth inch diameter and about one half inch diameter plastic tubing.

In rejecting Claim 30, the Examiner admits that Borden does not disclose that the second container is a bag with bottom folded gusset. However, the Examiner takes Official Notice that such type of bag with bottom folded gusset is "old, available, and known in the art." The Examiner then concludes that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted Borden's second container, by having a bag with bottom folded gusset, as a matter of engineering design choice, in order to make it convenient carrying the product around after transferring the liquid to the second bag." It is respectfully submitted that the Examiner's rejection appears to be premised on impermissible hindsight reasoning.

In rejecting Claim 31, the Examiner asserts that "it is inherent that Borden's system will disclose a set of instructions to advise customers with the best way of using the system." It is respectfully submitted that the Examiner is merely assuming that Borden's system would come with a set of instructions. However, it is not always the case that every product sold comes with instructions. One reason that Borden's system might not come with instructions is that it is very simple to use, and, unlike Applicant's invention, does not include a kit with many parts. As mentioned, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

In rejecting Claims 54 and 61, the Examiner admits that Borden does not disclose at least one flexible squeeze-tube structured and arranged so that it can be folded substantially flat to expel air from within such flexible squeeze-tube. To make up for this deficiency, the Examiner takes Official Notice that such flexible squeeze-tube being structured and arranged so that it can be folded substantially flat to expel air from within such flexible squeeze-tube is old, available, and known in the art. It is respectfully submitted that a flexible squeeze-tube structured and arranged in this manner is novel. Accordingly, it is respectfully submitted that the Examiner's taking Official Notice is inappropriate. It is respectfully requested that the Examiner provide evidence in support of the assertion, or the rejection be withdrawn.

Former Chief Judge Markey of the Federal Circuit has stated, "virtually all inventions are 'combinations', and ... every invention is formed of 'old elements' ... Only God works from nothing. Man must work with the elements." H.T. Markey, *Why Not the Statute?*, 65 J. Pat. Off. Soc'y 331, 333-34 (1983). Applicant respectfully points out that Applicant's use of: a plurality of containers; travel-bags; syringes; gussets; and flexible squeeze tubes; respectively, in combination with applicant's other limitations, is new and non-obvious.

Applicant herein repeats by reference, as though fully set forth herein, applicant's entire argument that the Borden reference is not a proper 35 USC §102 reference; and thus the Borden reference should not be used as the primary reference for a 35 USC §103(a) obviousness rejection.

ISSUE 6: Under 35 USC §103(a), is independent Claim 47 unpatentable over Borden's "liquid transfer system for bottles", in view of Krstovic's "vehicle oil drainage apparatus and method"?

Applicant's independent Claim 47 sets forth the requirement that "(g)...said at least one second container comprises at least one flexible squeeze-tube". Applicant respectfully submits that the cited references, either alone or in combination, do not disclose or suggest the at least one flexible squeeze-tube.

The Examiner admits that Borden does not disclose that the at least one second container comprises at least one flexible squeeze-tube. To make up for this deficiency, the Examiner relies on Krstovic. The Examiner asserts that Krstovic discloses a "similar adapter element system kit" with a second container "being [the] flexible squeeze-tube." The Examiner then concludes that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted Borden's second container 38 by [using the] flexible plastic container, as suggested by Krstovic, in order to make it easier [to] transfer the interior of the container by squeezing."

The Examiner refers to Krstovic's container D for the "flexible squeeze-tube". As best understood, it appears that the Examiner has taken note of Krstovic, at col. 2, lines 36-38, which states that container D "may be a flexible plastic bag and the like or it may be rigidly conformed in such a configuration as a bottle and the like". However, it is respectfully submitted that container D is not a flexible squeeze-tube. Whether container D is constructed as "a flexible plastic bag" or "rigidly conformed in such a configuration as a bottle", such would not be a "flexible squeeze-tube"

within the ordinary meaning of these words and terms. In particular, a "flexible plastic bag" lacks a hollow, cylindrical body, and a rigid bottle is not squeezable.

Furthermore, the MPEP requires that the words of the claim must be given their plain meaning. The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention. *See*, MPEP §2111.01(III). It is respectfully submitted that the term "squeeze-tube" was an industry term at the time the time of the invention customarily used by artisans of ordinary skill in the art to refer to a small cylinder of metal or plastic sealed at one end and having a capped opening at the other from which paint, toothpaste, or some other semi-fluid substance may be squeezed.

Additionally, it is respectfully submitted that the asserted motivation to substitute Krstovic's container for the receiving container in Borden's system, namely, "to make it easier to transfer the interior of the container by squeezing," makes no sense. Borden's system involves transferring liquid from a first container to a second container. After substituting a flexible plastic bag for the receiving container, squeezing the receiving container would not make it any easier to transfer the liquid. In fact, it could result in some liquid being transferred back to the first container, an undesirable result. Furthermore, it would make Borden's system more difficult to use since such a system is based on gravity draining to transfer liquid from the first container to the second container, and all that a user must do is place the adapters on the bottles, and place the bottles in their proper positions, and wait for the transfer to occur. (Furthermore, substituting a rigid bottle for the second container renders the asserted motivation meaningless since such bottle cannot be squeezed).

Borden's system requires gravity draining an upside down first bottle into a second receiving bottle, as shown in Borden's Figure 1 (See also Borden's Detailed Description column 3, lines 17-34). More specifically, Borden states, "The liquid transfer system for bottles is stable because the

weight of the nearly full bottle is on the bottom with the nearly empty inverted bottle on top” (See Borden’s Detailed Description column 3, lines 31-34). Borden’s arrangement clearly requires the use of rigid, non-flat-when-empty bottles, which lack the spatially efficient storage function and ease-of-transport function provided by applicant’s system of using flat flexible squeeze-tubes. It is respectfully submitted that this gravity draining technique teaches away from Applicant’s invention, and that, as such, one of ordinary skill in the art would not have been led to combine Borden with another reference to arrive at Applicant’s claimed subject matter. In fact, one of ordinary skill would have been led away.

IX. CONCLUSION

Applicant believes that all of the Applicant's Claims are about the ease of transport and efficient storage of utilizing "flexible squeeze-tubes", and are allowable with respect to 35 USC §102(b) and 35 USC §103(a). It is respectfully requested that the Examiner be reversed and that Claims 16-28, 30-32, 47, 53-55, 57 and 61 be allowed.

The previously paid notice of appeal fee and appeal brief fee will be applied to this new appeal. However, if there are any further fees necessitated by the foregoing communication, please charge such fees to our Deposit Account No. 50-1887, or if the amount submitted herewith is greater than the amount required, please credit any overpayment to our Deposit Account No. 50-1887.

Respectfully submitted,

Date: June 27, 2007



George D. Morgan (46,505)
Stoneman Law Offices
3113 North 3rd Street
Phoenix, AZ 85012
(602) 263-9200
Attorney for Applicant

X. CLAIMS APPENDIX

1-15 (canceled)

- 16) The adapter element system kit according to claim 47 comprising a plurality of said receiving adapters.
- 17) The adapter element system kit according to claim 16 comprising a plurality of said second containers.
- 18) The adapter element system kit according to claim 47 comprising a plurality of said second containers.
- 19) The adapter element system kit according to Claim 47 further comprising at least one plunger syringe.
- 20) The adapter element system kit according to Claim 19 wherein said at least one plunger syringe comprises at least one catheter syringe with a capacity of about sixty cubic centimeters.
- 21) The adapter element system kit according to Claim 19 wherein said at least one plunger syringe further comprises at least one flexible tube.
- 22) The adapter element system kit according to Claim 21 wherein said at least one flexible tube is between about one-eighth inch diameter and about one-half inch diameter plastic tubing.
- 23) The adapter element system kit according to Claim 17 further comprising a travel-bag structured and arranged to hold and portably transport said plurality of second containers, and said plurality of receiving adapters.
- 24) The adapter element system kit according to Claim 17 wherein said plurality of second containers comprises:
 - a) at least one second container comprising a first capacity; and
 - b) at least one second container comprising a second capacity.

- 25) The adapter element system kit according to Claim 47 further comprising at least one o-ring structured and arranged to assist in providing a seal between said at least one receiving adapter and said at least one second container.
- 26) The adapter element system kit according to Claim 47 wherein said at least one second container comprises at least one spout.
- 27) The adapter element system kit according to Claim 26 wherein said at least one spout comprises at least one non-spill valve.
- 28) The adapter element system kit according to Claim 26 further comprising at least one lanyard.
- 29) (canceled)
- 30) The adapter element system kit according to Claim 47 wherein said at least one flexible bag comprises at least one combination selected from the group consisting of:
 - a) bottom-gusset and at least one side gusset,
 - b) bottom-gusset only, and
 - c) at least one side gusset with bottom-fold.
- 31) The adapter element system kit according to Claim 16 further comprising at least one set of instructions.
- 32) The adapter element system kit according to claim 17 wherein said plurality of second containers comprises a plurality of flexible squeeze-tubes.
- 33-46 (canceled)

- 47) An adapter element system kit, for assisting pouring of a flowable substance from at least one first container comprising at least one first threaded opening to at least one second container having at least one second threaded opening, comprising:
- a) at least one adapter cap comprising at least one Yorker tip;
 - b) wherein said at least one adapter cap is structured and arranged to connect to the at least one first threaded opening of the at least one first container;
 - c) at least one receiving adapter comprising at least one access structured and arranged to flowably connect with said at least one Yorker tip of said at least one adapter cap;
 - d) wherein said at least one receiving adapter comprises at least one threaded port structured and arranged to connect with said at least one second opening of said at least one second container; and
 - e) the at least one second container;
 - f) wherein said at least one receiving adapter is structured and arranged so that the flowable substance may be transferred through said at least one adapter cap connected to said at least one receiving adapter directly from the at least one first container to said at least one second container;
 - g) wherein said at least one second container comprises at least one flexible squeeze-tube.
- 48) (canceled)
- 49) (canceled)
- 50) (canceled)
- 51) (canceled)
- 52) (canceled)

- 53) The adapter element system kit according to claim 47 wherein said at least one second container is smaller than the at least one first container.
- 54) The adapter element system kit according to claim 47 wherein said at least one flexible squeeze-tube is structured and arranged so that it can be folded to expel substantially all air from within such flexible squeeze-tube.
- 55) The adapter element system kit according to claim 47 further comprising at least one o-ring structured and arranged to assist in providing a seal between said at least one receiving adapter cap and said at least one second threaded opening of the at least one second container.
- 56) (canceled)
- 57) The adapter element system kit according to claim 47 wherein said at least one flexible squeeze-tube comprises:
- a) at least one first end and at least one second end;
 - b) wherein said at least one empty flexible squeeze-tube is new and unused for containment;
 - c) wherein said at least one first end comprises a reclosable access system wherein said reclosable access system, when closed, seals such at least one first end; and
 - d) wherein said at least one second end comprises a permanent "linear" tube seal closure.
- 58-60. (canceled)
61. The adapter element system kit according to Claim 47 wherein said at least one flexible squeeze-tube is structured and arranged so that it can be folded substantially flat.

XI. EVIDENCE APPENDIX

None.

XII. RELATED PROCEEDINGS APPENDIX

None.